

REMARKS

Claims 1, 7-9, and 13-20 are all the claims presently pending in this application. Claims 2-6 and 10-12 have been canceled in part in reliance upon the Examiner implication of allowable subject matter, since the previous rejection failed to address the features of various claims and Applicant incorporated their contents into the independent claims. Independent claims have been amended to clarify the wording of the invention.

It is noted that the amendments, if any, are made only to more particularly define the invention and not for distinguishing the invention over the prior art, for narrowing the scope of the claims, or for any reason related to a statutory requirement for patentability. It is further noted that, notwithstanding any claim amendments made herein, Applicant's intent is to encompass equivalents of all claim elements, even if amended herein or later during prosecution.

Claims 1-2, 7-9 and 13-20 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Okano, UK Pat. No. 2,343,335, further in view of US Application Publication 2001/0023182 to Bach et al, and further yet in view of US Patent 7,062,303 to Guterman.

Claims 16-18 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Okano/Bach/Guterman, further in view of US Application Publication 2001/0023182 to Bach et al, and further yet in view of Usami (presumably, since USPN 7,062,303 is actually issued to Guterman, the rejection intended to refer to either US Patent Publication 2002/0049072 or EP Application No. 1,199,900).

Claim 3 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Okano/Bach/Guterman, further yet in view of U.S. Pat. App. Pub. No. 2004/0192412 to Ono et al.

These rejections are respectfully traversed in view of the following discussion.

I. APPLICANT'S CLAIMED INVENTION

The claimed invention, as defined, for example, by independent claim 1, (and similarly independent claim 9) is directed to a mobile terminal including, a battery, a power supply block which supplies power of the battery, a radio communication block which communicates with a base station when the power is supplied from the battery through the power supply block, a first switch which is interposed between the power supply block and the radio communication block, a key operation section to which the power is always

supplied from the battery through the power supply block, and a control unit which controls the first switch to stop the power supply from the battery to the radio communication block to stop communication between the mobile terminal and the base station in response to a manual operation of the key operation section, a base band block which is connected with the first switch, an application function block to which the power is always supplied from the battery through the power supply block and is possible to accomplish application functions, and a second switch which is interposed between the application function block and the base band block, wherein the power supply to the base band block is stopped when the control unit controls the first switch to stop the power supply from the battery to the radio communication block in response to the manual operation of the key operation section, and wherein the control unit is contained in the application function block and controls the second switch to disconnect the base band block from the application function block.

The claimed invention, as defined, for example, by independent claim 15, is directed to mobile terminal including, a battery, a power supply block which supplies power of the battery, a radio communication block which communicates with a base station when the power is supplied from the battery through the power supply block, a first switch interposed between the power supply block and the radio communication block, a key operation section to which the power is always supplied from the battery through the power supply block, a base band block to which the power is always supplied from the battery through the power supply block which accomplishes application functions other than a communication function using the radio communication block, a second switch interposed between the base band block and the radio communication block, a control unit which is responsive to a manual operation from the key operation section that controls the first switch to stop the power supply from the battery to the radio communication block, and controls the second switch to stop communication between the base band block and the radio communication block.

II. THE PRIOR ART REJECTIONS

The Examiner alleges that one having ordinary skill in the art would have motivated to modify primary reference Okano by teachings in Bach and Guterman and that such combination would render obvious claims 1, 2, 7-10, and 13-15, and, if Okano/Bach/Guterman were further modified by Usami, claims 16-18 would be rendered obvious, and, if Okano/Bach/Guterman were further modified by Ono, claim 3 would be rendered obvious.

In general, Applicant respectfully submits that this new rejection fails to establish a *prima facie* rejection, since, as explained below, even if these references were combined, not

all elements of the independent claims would be demonstrated. Moreover, also as explained below, it would be improper to make the combination of these references.

First, it is pointed out that independent claim 1, as the result of the failure in the previous rejection to address claim 6, was previously placed into condition of being substantially a “picture claim” of the exemplary configuration shown in Figure 2, and claim 15 was amended to be substantially a “picture claim” of Figure 1.

Second, Applicant submits that primary reference Okano does not teach using a first switch that stops the power supply to the radio communication block. That is, the switch 12 in Figure 1 of Okano interrupts only the power to the transmission section 8 and does not interrupt power to receiving section 7. As explained on page 2 of Okano, particularly at lines 10-12 and 22-28, this design intends to be able to disable only the transmitter while specifically permitting the reception capability to continue (e.g., see line 6 of page 7).

This unique design in Okano is directed to the problem of being able to disable the transmission of a cell phone from interfering with other electronic devices, such as medical or aircraft electronics, while permitting the other functions to operate (e.g., see lines 5-8 of page 2).

It is clear from this description that a primary purpose of primary reference Okano is to continue to have receiving section 7 operate even if the transmitting section 8 has power removed. Therefore, Applicant respectfully submits that the Examiner is factually incorrect in characterizing primary reference as having a radio communication block for which first switch 12 interrupts power, since switch 12 clearly interrupts power to only the transmitting section 8 in Okano.

Moreover, Applicant submits that, as a matter of law, it would be improper to modify primary reference Okano to conform with the description in the independent claims that the communication function is completely disabled, since interrupting power to receiving section 7 would defeat the purpose of Okano, as described in MPEP §2143.01: “*If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.*” (*In re Gordon*, 733 F2d 900, 221 USPQ 1125 (Fed. Cir. 1984))

Therefore, Applicant submits that the rejection currently of record fails to establish a *prima facie* rejection since, even if all cited references were to be combined as urged by the Examiner, the combination would still fail to provide the result described in the independent claims.

The Examiner relies upon the cited secondary references for reasons unrelated to

overcoming this fundamental deficiency of primary reference Okano, so that these secondary references do not overcome this deficiency in Okano.

Hence, turning to the clear language of the claims, in Okano there is no teaching or suggestion of: “ ... said first switch to stop the power supply from said battery to said radio communication block to stop communication between the mobile terminal and the base station in response to a manual operation of said key operation section”, as required by independent claim 1. The remaining independent claims have similar language, and Applicant submits that all pending claims are clearly patentable over Okano.

Therefore, Applicant submits that there are features of the present invention which are not demonstrated in Okano, even if modified by the cited secondary references and even if it were consider proper to modify Okano by these secondary references, and the Examiner is respectfully requested to reconsider and withdraw this rejection based on Okano.

Turning now to details of the rejections of record, relative to the rejection for claims 1, 2, 7-10, and 13-15, based upon modifying Okano by Bach and Guterman, Applicant respectfully submits the following.

Relative to the rejection for independent claims 1 and 9 (see Figure 2 of the present application), Applicant respectfully submits, as pointed out above, that the rejection errs as a matter of fact in alleging that primary reference Okano demonstrates a communication block for which switch 12 controls power. Switch 12 only controls power to the transmission section 8. Moreover, assuming *arguendo* that control circuit 1 of Okano is considered (as broadly interpreted) to include an application function block, Okano clearly has no second switch between the application block and the communication block, as is shown in Figure 2 of the present application, and clearly has no need for such second switch without additionally changing the principle of operation of Okano (which change of principle of operation is not permitted in a prior art evaluation, as clearly described in MPEP §2143.01: “*If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious.*” *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959)).

Although the rejection of record is somewhat garbled, in view of the above-described mischaracterizations of primary reference Okano, and not at all understood by Applicant, the Examiner seems to rely upon secondary references, Bach and Guterman, for purpose of inserting the second switch between the application block and the base band block.

However, as pointed out in the paragraph above, inserting a second switch into Okano

would at least change the principle of operation and would, therefore, be improper. Moreover, Applicant respectfully submits that the Examiner mischaracterizes secondary reference Bach, since this reference has nothing to do with conserving power. Rather, Bach provides a special mode to allow the user to be alerted while in a meeting to permit the user to exit the meeting before taking the call, or to completely block all calls for a pre-programmed time period (e.g., see Abstract).

Relative to secondary reference Guterman, Applicant respectfully brings to the Examiner's attention that this reference is related to an automatic power conservation process, not a manual input as the Examiner seemingly attempts to apply this reference.

Thus, Applicant submits that modification of Okano by either Bach or Guterman would not be proper.

The rejection for claim independent 15 has similar problems as described above, except that claim 15 is directed to the configuration shown in Figure 1 of the present application.

The analysis for dependent claims 2, 7, 8, 10, 13, 14, 19, and 20 inherit the deficiencies identified above for the rejection of their respective independent claims.

Relative to the rejection for claims 16-18, based upon further modifying Okano/Bach/Guterman by Usami, Applicant again submits that the insertion of the second switch would change the principle of operation and defeat the purpose of the primary reference Okano and, thus, be improper. Again, Applicant points out that the remaining independent claims are substantially picture claims of Figures 1 and 2 of the present application, and the claimed details in the independent claims are not reasonably demonstrable in either Okano or Usami.

Relative to the rejection for claim 3, based upon further modifying Okano/Bach/Guterman by Ono, Applicant respectfully submits that Ono does not demonstrate a switch between the two processors, as would be required to satisfy the plain meaning of the claim language. Switch 1025 clearly controls audio to the two processors, an entirely different concept.

III. FORMAL MATTERS AND CONCLUSION

In view of the foregoing, Applicant submits that claims 1, 7-9, and 13-20, all of the claims presently pending in the application, are patentably distinct over the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue at the earliest possible time.

Should the Examiner find the application to be other than in condition for allowance,

S/N: 10/690,637 (KUD.069)

the Examiner is requested to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary in a telephonic or personal interview.

The Commissioner is hereby authorized to charge any deficiency in fees or to credit any overpayment in fees to Attorney's Deposit Account No. 50-0481.

Respectfully Submitted,

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